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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/661,393      | 09/12/2003  | Robert William Collins |                     | 8416             |

7590 07/12/2006

Kenneth W. Iles  
Law Offices of Kenneth W. Iles  
9903 West 129th Street  
Overland Park, KS 66213-3222

EXAMINER

HOGE, GARY CHAPMAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/661,393 | <b>Applicant(s)</b><br>COLLINS, ROBERT WILLIAM |  |
|                              | <b>Examiner</b><br>Gary C. Hoge      | <b>Art Unit</b><br>3611                        |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,7-10,12,13,16,17 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4,7-9 and 25 is/are allowed.
- 6) ☒ Claim(s) 10,13,16,17 and 19-24 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. In view of Applicant's remarks, **the finality of the previous Office action is hereby withdrawn.** The amendment filed May 30, 2006 has been entered, and a new Office action, in response to that amendment, follows.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13, 17 and 19-24 are are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 13, there is no antecedent basis for "said transparent reminder pocket." It appears that claim 13 was intended to depend form claim 12, rather than claim 10. For examination purposes, claim 13 will be treated as if it did depend from claim 12.

Regarding claim 17, the edge of the envelope below the reminder card in Fig. 4 has been defined as a "bottom flap score line," but the upper edge of the display supporting panel, which is at the opposite end of the envelope is also defined as a "bottom edge," thus rendering the claim confusing. A consistent frame of reference must be used to define both the reminder card and the display supporting panel.

#### *Claim Objections*

4. Claim 10 is objected to because of the following informalities: on line 11, it appears that "a" should be inserted before "strip of adhesive". Appropriate correction is required.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powell (3,365,117) in view of Transport (4,291,798) and Fox (2,845,733), as applied to claim 17, above, and further in view of Klein (5,755,433).

Powell discloses an envelope having a front face 4 and a rear face 5; and means 9 for reminding a recipient of an event (e.g., dropping film off to be processed); and means 12, 13 for readily removing the reminder means from the envelope. A reminder pocket comprises a transparent window 18 that is secured to a front face of a flat pattern blank of the envelope by an adhesive applied along four of its edges (and therefore any three of its edges). However, Powell does not disclose a means of displaying the envelope. Transport teaches that it was known in the art to provide an envelope with a display supporting panel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the envelope disclosed by Powell with a display supporting panel, as taught by Transport, in order to display the envelope in an upright position, perhaps to remind the film technician of pending orders.

Further, the display supporting panel 29 disclosed by Transport is attached to a sealing flap by a tongue-and-groove connection, rather than by adhesive. Fox teaches that it was known in the art to use adhesive to connect such elements. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use adhesive to connect the display

supporting panel disclosed by Transport to the sealing flap, as taught by Fox, in order to make the connection more secure.

Still further, the adhesive disclosed by Fox does not include a peel away release strip. Klein teaches that it was known in the art to provide such a strip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the envelope disclosed by Powell, as modified, with a peel away release strip, as taught by Klein, to allow the user to seal the envelope without having to lick it.

Regarding claim 16, see Fig. 2 of Fox.

***Allowable Subject Matter***

7. Claims 1, 2, 4, 7-9 and 25 are allowed.
8. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claim 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
10. Claims 17 and 19-24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Response to Arguments***

11. Applicant's arguments filed May 30, 2006 have been fully considered but they are not persuasive.

Regarding claim 10, Applicant merely states that "Claim 10 has been amended to include significant limitations regarding the structure that leads to the display mode as shown in Fig. 15, 16 . . ." First, it is noted that Figs. 15 and 16 illustrate a non-elected invention. In the response filed May 18, 2005, Applicant elected, without traverse, the species illustrated in Figs. 1-8. Second, although claim 10 has, in fact, been significantly amended, it is now merely a repetition of claim 18, which was rejected in the previous Office action.

### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary C Hoge  
Primary Examiner  
Art Unit 3611

gch